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DIRECTOR OFFICE
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DECISION GRANTING
PETITION UNDER
37 CFR §1.183

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N.W.
SUITE 800
WASHINGTON, DC 20006-1021

In re Application of :
Oshima, et. al. :
Application No. 09/686,466 :
Filed: October 12, 2000 :
Attorney Docket No. 2000-1422 :

This is a decision on the April 15, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$130.00 has been received and processed for the petition under 37 CFR 1.183.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on June 30, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on May 30, 2003 is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

The reissue application was originally filed with a specification that did not comply with 37 CFR 1.173(a)(1). On June 30, 2003, a substitute specification was filed together with a supplemental amendment. Within the "REMARKS" section of the supplemental amendment, applicant states: "The specification and abstract have been amended and replaced with the attached substitute specification, which indicates the changes with bracketing and underlining as required for reissue applications. No new matter has been added." The first page of the substitute specification was marked with the notation (N.E.), i.e., Not Entered. However, on page 2 of the Office action mailed

December 23, 2003, the examiner states in paragraph 2, "The substitute specification and abstract filed on 06/30/03 has been entered."

Petitioner is requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that "In several of the applications, the Examiner required a substitute specification because of the length of the specification and the number of amendments, and indicated by telephone that substitute specifications would be required in all of the related reissue applications."¹ The petitioner continues by stating "...in the parent reissue application 09/244,037 the replacement paragraph amendments were filed on April 30, 2003. Then in the Office Action mailed July 29, 2003, the Examiner required a substitute specification. Also in related reissue application 09/662,695, which like the present application is a reissue application of U.S. Patent 5,600,672 and a divisional application of reissue application 09/244,037, the replacement paragraph amendments filed on May 7, 2003 were denied entry and a substitute specification was required in the Office Action mailed May 27, 2003".

This basis is considered to be sufficient for granting the petition. The rule will be waived to comply with the requirement of the examiner, since there is no other way to present the required substitute specification, and the requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on June 30, 2003 is accepted, and will be entered.
3. The reissue application file is being forwarded to the Technology Center for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Dwayne D. Bost, TC2600 SPRE, at (703) 305-4778.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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¹ No other record of the referenced telephone conversation can be found in this application file.